

REMARKS

The present amendment and remarks are in response to the non-final Office Action entered in the above identified case and mailed on April 8, 2004. Claims 17-29, 63-75 and 123-141 remain pending in the application. The drawings were objected to under 37 CFR 1.83(a). Claims 22 and 128 were rejected under 35 U.S.C. §112 as being indefinite. The Examiner has indicated that claims 17-21, 23-29, 63-75, 123-127, 129-136, and 140 are allowed. The Examiner has further indicated that claims 22 and 128 would also be allowable, but for the §112 rejection.

Regarding the objection to the drawings, Applicant respectfully traverses. Figure 25 Item 114 clearly shows mapping coefficient memory. Figure 25 relates to Figure 24 which relates to Figure 1, and therefore, the mapping coefficient memory is properly disclosed in the present application. The present application is a divisional application based upon Application No. 08/892,570 (“570”). In response to a restriction requirement raised during the prosecution of the ‘570 application, Applicant identified the different Species of claims and the Figures corresponding to such, and elected to continue prosecution of Species 1 corresponding to Figures 1-23, 27 and 28 as evidenced by the Election of Species filed by Applicant on February 25, 2000.

Applicant then filed the present divisional application based upon the other Species identified in filed by Applicant on February 25, 2000. The Election of Species filed by Applicant on February 25, 2000 clearly shows that all of the Species correspond to Figure 1. In addition, the Election of Species clearly indicates that Figures 2, 5, 9, 16, 18 and 19 correspond to Species 1 which claims were prosecuted in the ‘570 application. Because Figures 2, 5, 9, 16, 18 and 19 relate to features independent of the mapping coefficient memory, they properly omit reference to such. As such, Applicant respectfully submits that Item 114 of Figure 25, which relates to Item 101 and/or 102 of Figure 24, which relates to Item 1 of Figure 1, properly discloses a mapping coefficient memory. The disclosure of a mapping coefficient memory is sufficient to support the elements of the claims relating to the storage and retrieval of such mapping coefficients. The drawings as they presently stand show proper support for the claims and the application is in condition for allowance.

Claim 22 has been amended so that proper antecedent basis now exists throughout the claim. Regarding claim 128, Applicants wishes to point out that it addressed and corrected the phrase objected to by the Examiner at ¶3, subsection (2) of the Office Action dated April 8, 2004 in its last amendment submitted on October 31, 2001. Claim 128 has been currently amended to address the phrase objected to in ¶3, subsection (3) of the Office Action dated April 8, 2004. As such, appropriate corrections have been made with this amendment and Applicant respectfully submits that the rejected claims are now sufficiently definite to meet the requirements of 35 U.S.C. §112.

Claims 137-139, and 141 are subject to a statutory double patenting rejection under 35 U.S.C. §101 in light of U.S. Patent No. 6,198,770 (the ‘770 patent). According to the examiner, claims 137, 138, 139 and 141 claim the same invention as that of claims 5, 33, 38, and 56 of the ‘770 patent respectively. With respect to claims 137-139 and 141 Applicant respectfully traverses.

In determining whether a statutory double patenting rejection is in order, it is necessary to determine whether the claims of the application claim the same invention as claimed in the issued patent. According to §804A of the MPEP, “same invention” means identical subject matter. Applicant wishes to point out that the scope of the rejected claims is not commensurate with the claims cited in the ‘770 patent and that claims 137-139 and 141 are patently distinct from the claims cited in the ‘770 patent. For example, claim 137 of the application includes “means for outputting the corrected data as the image data of the second hierarchy in accordance with the determined result.” Although a similar means is present in claim 5 of the ‘770 patent, claim 5 is a dependent claims that includes all of the limitations of intervening claim 4. Many, if not all of the limitations of claim 4 of the ‘770 patent are not present in claim 137 of the application. Thus, the scope of claim 137 of the application is not commensurate with that of claim 5 of the ‘770 and the two are patentably distinct.

A similar situation arises with regard to claim 138 of the application and claim 33 of the ‘770 patent. Claim 138 of the application includes “means for outputting the corrected data as the image data of the third hierarchy in accordance with the determined result.” Although a similar means is present in claim 33 of the ‘770 patent, claim 33 is a dependent claim that includes all of the limitations of intervening claims 31 and 32. Many, if not all of the limitations

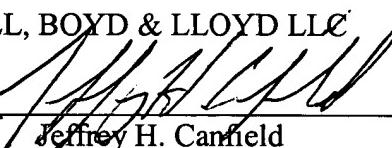
of claims 31 and 32 of the '770 patent are not present in claim 138 of the application. Thus, the scope of claim 138 of the application is not commensurate with that of claim 33 of the '770 patent and the two are patentably distinct.

The same situation repeats with claims 139 and 141 of the application and claim 38 and 56 of the '770 patent. The claims of the application contain elements not found in the base claims of the patent, and a dependent claim of the patent that includes similar features to those in claims of the application but absent from the base claim of the patent includes elements of intervening claims that are not included in the claims of the application. The scope of the claims of the application is not the same as the scope of the claims of the patent, and the two are patentably distinct.

Applicant respectfully submits that all of the pending claims are now in condition for allowance and requests that the Examiner allow the application to issue. However, if there are any remaining issues the Examiner is encourage to call Applicant's attorney, Jeffrey H. Canfield at (312) 807-4233 in order to facilitate a speedy disposition of the present case.

If any additional fees are required in connection with this response they may be charged to deposit account no. 02-1818.

Respectfully Submitted,

BELL, BOYD & LLOYD LLC
BY 
Jeffrey H. Canfield
Reg. No. 38,404
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4233

Dated: July 6, 2004